

BERNHARD MUSSIG
USSN 09/156,886
REPLY TO OFFICE ACTION DATED JANUARY 28, 2004
REQUEST FOR RECONSIDERATION OF JANUARY 28, 2005

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicant respectfully requests that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the following comments.

The sole remaining issue is the rejection of claims 37-55 under 35 USC § 103(a) as being obvious over Koga et al. ("Koga"), EP 661 364, in view of Dobashi et al. ("Dobashi"), US 5,643,676. In response, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

The Examiner now appears to agree that the data in the instant specification show that the

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inclusion of the diene component in the adhesive is *critical* to the production of protective film that can be removed from a painted vehicle substrate without defect. Thus, the Examiner writes in the first sentence of the last paragraph on page 4 of the Office Action that "[i]t is noted applicants results show including a diene component in the adhesive produces a protective film that is removed from a substrate without defect."

Since the criticality of incorporating the diene component has been proven, Applicant submits that any *prima facie* case of obviousness has been rebutted, as a matter of law. The Examiner concedes that Koga does not teach the criticality of the diene component when he states that "the dienes comprise 0-50% by weight of the adhesive layer (emphasis added.)" (If the dienes can be present or not, as desired, their presence is not essential.) The Examiner also concedes that Koga is "silent as to using the protective film for protecting the paint finish of a vehicle." Thus, at best, Koga only establishes a *genus* (dienes or no dienes) of which the present invention (dienes) has been proven to be a *patentably distinct species* in view of the showing of criticality.

There is nothing in Dobashi alone or in its combination with Koga that changes the import of the data in the instant specification. Even if were true that Dobashi would have suggested to a person having ordinary skill in the art that Koga's protective film would have been useful to protect the finish of a vehicle—which Applicant does not concede—the

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combination still would not have suggested that the instant protective film (requiring a diene) would be any better at protecting the finish of a vehicle than would other similar protective films (not having a diene). Koga suggests films with dienes and without dienes would be equally useful for the instant purpose. The Examiner has not explained whether or how the fact that dienes would lower the glass transition of the adhesive layer, or improve the low temperature adhesive characteristic or provide an adjustable initial tack would have led a person skilled in the art to expect that including dienes in the adhesive would improve the painted vehicle substrate protection properties as shown instantly. Yet, the instant data shows that such properties are clearly improved, and the Examiner appears to concede this fact. Since the cited combination of references does not suggest this particular improvement, Applicant submits again that the data of record prove an unexpected result.

The Examiner says Koga discloses the self-adhesive protective film protects "coated metal plates," and this includes the paint finish of an automobile. Assuming for the sake of argument that this was true, there still is no teaching in Koga that the films with dienes are any better for this purpose than the films without dienes. So, again, there simply is a failure in Koga or in the combination of Koga and Dobashi to lead a person skilled in the art to expect that the inclusion of the diene in the film should be beneficial for protecting the paint finish of a vehicle. Yet such protection is exactly what Applicant claims, and, moreover, a benefit in that specific purpose has been demonstrated to occur when dienes are incorporated into the adhesive. This is

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completely unexpected in view of the combination of Koga and Dobashi. Consequently, Applicant's demonstrated unexpected improvement must be considered objective evidence of nonobviousness.

Respectfully, Applicant submits that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicant believes that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicant also believes that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

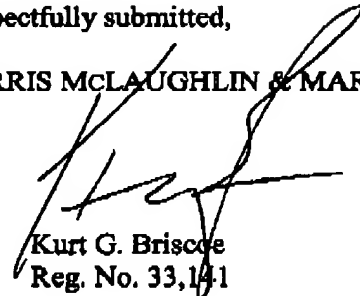
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Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By


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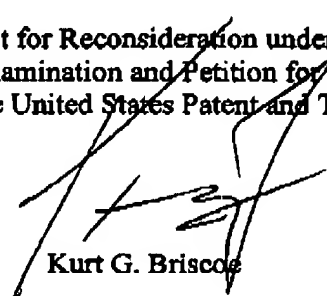
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Request for Reconsideration under 37 CFR § 1.111 and the accompanying Request for Continued Examination and Petition for Extension of Time (9 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: January 28, 2005

By:


Kurt G. Briscoe